<u>REMARKS</u>

<u>Status of the Claims</u>

Claims 1–27 remain pending in the application, Claims 1, 14, and 27 having been amended to more clearly define the present invention.

<u>Claims Rejected under 35 U.S.C. § 102(e)</u>

The Examiner has rejected Claims 1-27 as being anticipated by Buxton et al. (U.S. Patent No. 6,469,714, hereinafter "Buxton"). The Examiner asserts that Buxton describes each element of applicants' claimed invention. Applicants respectfully disagree with the rejection. Nevertheless, applicants have amended independent Claims 1, 14, and 27 to more clearly define the invention, as further discussed below. In the interest of reducing the complexity of the issues for the Examiner to consider in this response, the following discussion focuses on amended independent Claims 1, 14, and 27. The patentability of each remaining dependent claim is not necessarily separately addressed in detail. However, applicants' decision not to discuss the differences between the cited art and each dependent claim should not be considered as an admission that applicants concur with the Examiner's conclusion that these dependent claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to discuss differences between the prior art and every claim element, or every comment made by the Examiner, should not be considered as an admission that applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent claims patentably distinguish over the references cited. However, a specific traverse of the rejection of each dependent claim is not required, since dependent claims are patentable for at least the same reasons as the independent claims from which the dependent claims ultimately depend.

With regard to amended independent Claim 1, applicants' method is clearly distinguishable over Buxton because Buxton does not create a palette such that the palette and its associated contents do not obscure the viewable content of the electronic document, and Buxton does not create a customized palette. The Examiner asserts that Buxton clearly shows palette 322 displayed so as to not obstruct the viewing of the document in FIGURE 3A (Office Action, page 8, lines 4-6). However, FIGURE 3B of Buxton shows that "Selection of a Main Menu item 326 results in a Pop-Up Menu of Quick-pick items 328" (Buxton, column 6, lines 64-65). Similarly, FIGURE 3C of Buxton shows that "Quick-pick items 328 appear in a Pop-Up palette 330 of choices from Action

1 Bar 322" (Buxton, column 6, lines 66-67). Thus, although the viewable content, i.e., the memo

2 examples in both figures are sufficiently short so that their viewable content does not extend to the

3 bottom of the screen such that the Pop-Up Menu and Pop-Up palette obscure them, it is clearly

4 evident that if the memos were longer so that they extended to the bottom of the screen, the Pop-Up

5 Menu and Pop-Up palette would indeed obscure the viewable content of the memos. More

6 specifically, this fact is evident in the spreadsheet example of FIGURE 4B, where Pop-Up Menu 330

7 has actually obscured a portion of the viewable content of the spreadsheet.

8 In contrast, as shown in applicants' FIGURE 5, the claimed method presents a palette and

9 modified palette to the side of a document so that the palette does not obstruct the viewing of the

10 document. Specifically, "the user can view the formatting palette 502 while viewing content 506 of

11 the electronic document 504 without the formatting palette 502 overlapping the viewable content 506

12 of the electronic document 504" (see applicants' specification, page 17, lines 8-11). Thus, if the user

13 decides to access the associated content of the palette in the form, for example, of pull down boxes

14 such as the size, style, or name pull down menus as shown in FIGURE 5, when these pull down

15 menus are activated to view various sizes, styles, and names that are available for selection, none of

16 the pull down menus will visually obscure the content of the electronic document. Since Buxton does

17 not even disclose or suggest the need to achieve this result, the reference clearly does not anticipate

18 or render obvious applicants' method of displaying the palette in conjunction with the electronic

19 document on the user interface.

20 Furthermore, since Buxton clearly refers to a palette as "palette 322" (Office Action, page 8,

21 line 5), it appears that the Examiner is asserting that applicants' palette as claimed is equivalent to

22 Buxton's Action Bar, since numerical reference 322 refers to the "Action Bar" (Buxton, column 6,

23 line 67). However, Buxton's Action Bar is not equivalent to applicants' claimed palette or modified

24 palette, since applicants' palette and thus modified palette are customized, i.e., they are based on the

25 context and the status of a property and include neither nonfunctional nor non-applicable items (see

26 applicants' specification, page 19, lines 30–page 20, line 2, and page 22, lines 13-18). Although

27 Buxton may discuss producing a customized graphic user interface based on a designer's input

28 (Buxton, column 6, lines 56-57), it appears that Buxton is not referring to anything equivalent to

29 applicants' customized palette, based upon Buxton's reference to the Action Bar as providing access

30 to the most common applet features of an applet (Buxton, column 7, lines 28-30). Use of an Action

Bar having features that are *common* in usage instead of an Action Bar that includes features that are unique to a specific usage indicates that Buxton does not create a truly customized user interface. Instead of reconfiguring the Action Bar when a selection property changes, as does applicants' method, Buxton simply "dims" a feature on the Action Bar without removing it (Buxton, column 7 lines 60-64). A "dimmed" feature in a palette does not represent a truly customized palette or a modified customized palette, but simply corresponds to a response to a condition in which a function in a menu cannot be implemented. Therefore, Buxton does not anticipate applicant's method of creating and displaying customized palettes.

Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for the reasons given above. Because dependent claims are considered to include all of the elements of the independent claims from which the dependent claims ultimately depend and because Buxton does not disclose or suggest all of the elements of independent Claim 1, the rejection of dependent Claims 2-13 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for at least the same reasons as the rejection of Claim 1.

With regard to amended independent Claim 14, applicants have also provided further clarification that patentably distinguishes their claimed method over Buxton. Claim 14 is directed to a computer system for providing a selection of formatting properties for an electronic document associated with an application program having a user interface. For the same reasons already noted in regard to Claim 1, amended Claim 14 also distinguishes over Buxton. Accordingly, the rejection of independent Claim 14 under 35 U.S.C. § 102(e) over Buxton should be withdrawn. Because dependent claims are considered to include all of the elements of the independent claims from which the dependent claims ultimately depend, and because Buxton does not disclose or suggest all of the elements of independent Claim 14, the rejection of dependent Claims 15-26 under 35 U.S.C. § 102(e) over Buxton should be withdrawn for at least the same reasons as the rejection of Claim 14.

With regard to amended independent Claim 27, applicants have also clarified the system that is defined by the claim, so that it clearly implements functions different than those of Buxton, in regard to the display of a modified palette. The modified palette is also customized so that it does not include properties, property labels, or controls that the user does not consider useful (see applicants' specification, page 22, lines 16-18), unlike Buxton's palette. In addition, the modified palette can be resized so that both the electronic document and the modified palette are simultaneously viewable

when the modified palette is displayed (see applicants' specification, page 22, lines 21-24). Again, it is apparent from the claim that the associated modified palette and its content do not obscure the viewable electronic document, unlike Buxton's Pop-Up Menu's that do obscure the viewable document. Thus, Claim 27 also distinguishes over Buxton for much the same reasons as those expressed above in connection with Claim 1. Accordingly, the rejection of independent Claim 27 under 35 U.S.C. § 102(e) over Buxton should be withdrawn.

Respectfully submitted,

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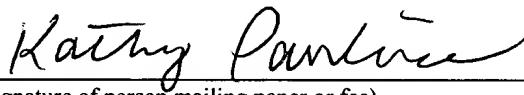
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